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REMARKS

On September 21, 2004, Applicant's representative Christopher M. Goff and Examiner Monique Jackson had a scheduled telephone interview to substantively discuss the Advisory Action dated August 24, 2004. During the interview, it was agreed that if Applicant merged claim 2 into claim 1, thereby amending claim 1 to require the elastic attachment adhesive composition to comprise between about 75% to about 90% rubber-based adhesive, that all pending claims after the amendment would be in condition for allowance.

Based on the interview, Applicant has amended claim 1 herein to require the elastic attachment adhesive composition to comprise between about 75% and about 90% rubber-based adhesive. Applicant canceled claim 2. Additionally, Applicant canceled claims 15-65 herein as being drawn to a non-elected invention. Applicant expressly reserves the right to file divisional applications directed towards these non-elected claims in the future. After entry of this Amendment B After Final Office Action, claims 1, 3-10 and 12-14 will be pending in this case. Applicant respectfully submits that the above amendments and cancellations place all pending claims in condition for allowance. Specifically, claims 1, 3-10, and 12-14 are to be allowed. No new matter has been added by any of the amendments made herein.

1. Rejection of Claims 1, 4-7, and 12-13 Under 35 U.S.C. §102(b)

Reconsideration is requested of the rejection of claims 1, 4-7, and 12-13 under 35 U.S.C. §102(b) as being anticipated by JP 62081470A.

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Claim 1, as amended herein, is directed to an elastic attachment adhesive composition comprising between about 75% and about 90% rubber-based adhesive, and between about 10% and about 30% crystalline polymer having a degree of crystallinity of at least about 40%. The rubber based adhesive is selected from the group consisting of styrene-isoprene-styrene, styrene-butadiene-styrene, styrene-ethylene/propylene-styrene, styrene/ethylene-co-butadiene/styrene, and styrene-poly(ethylene-propylene)-styrene-poly(ethylene-propylene). The elastic attachment adhesive composition is suitable for bonding together a first elastomeric substrate and a second substrate.

JP 62081470A discloses a hot-melt adhesive composition comprising (A) 5-70wt%, preferably 10wt% to 50wt%, copolymer obtained by the hydrogenation of a styrene-isoprene-styrene block copolymer or styrene-butadiene-styrene block copolymer; (B) 10-70wt% tackifier having a softening point of 60-150°C; and (C) 10-75wt% of crystalline polypropylene (e.g., a powdery polypropylene prepared by polymerizing propylene or by decomposing an isotactic polypropylene) having a number-average molecular weight of 20,000 or less. Optionally, another polymer (e.g., an ethylene-propylene copolymer), a wax, an extender oil, or an aggregate can be utilized.

Significantly, JP 62081470A fails to disclose and enable an adhesive composition comprising between about 75% and about 90% of a rubber based adhesive. This is a requirement of claim 1 and is a significant aspect of Applicant's invention.

As stated in M.P.E.P. §2131, a claim is anticipated only if each and every element of the claim is described in the prior art reference. As stated above, JP '470 fails to disclose an elastic attachment adhesive composition comprising between about 75% and

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about 90% rubber-based adhesive as required by claim 1. Further, the JP'470 reference specifically discloses that "an amount in excess of 70wt% [of rubber based adhesive] may not only reduce the adhesive strength but [will] also adversely affect the fluidity when the adhesive is being heated and melted, and this is undesirable."¹ As such, the JP'470 reference fails to teach each and every limitation of instant claim 1. As such, claim 1 is novel and patentable over the cited reference.

Claims 4-7, and 12-13 depend from claim 1 and are patentable for the same reasons as claim 1 set forth above, as well as for the additional elements they require.

2. Rejection of Claims 1-5, 12 and 14 Under 35 U.S.C.
§102(e)

Reconsideration is requested of the rejection of claims 1-5, 12 and 14 under 35 U.S.C. §102(e) as being anticipated by Mori (U.S. 6,248,834).

Claim 1 is discussed above.

Mori discloses a thermoplastic elastomeric composition comprising 100 parts by weight of a chlorinated polyethylene, from 5 to 1,000 parts by weight of a crystalline polyolefin resin and from 20 to 1,500 parts by weight of a rubber component. The rubber component can be a hydrogenated styrene type rubber obtained by hydrogenating a block polymer prepared from a polymer block of styrene or its derivative and a conjugated diene. Preferred dienes can include isoprene and butadiene. The crystalline polyolefin resin is a homopolymer or a copolymer of an α -olefin having from 2 to 20 carbon atoms.

Significantly, as with JP 62081470A, Mori fails to disclose

¹JP 62081470A at page 4.

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an adhesive composition comprising between about 75% and about 90% of a rubber based adhesive. This is a requirement of claim 1 and is a significant aspect of Applicant's invention.

As stated above, a claim is anticipated only if each and every element of the claim is described in the prior art reference.² Further, as stated in M.P.E.P. §2131.03 (Anticipation of Ranges), "when the prior art discloses a range which touches, overlaps, or is within the claimed range³, but no specific examples falling within the claimed range are disclosed,⁴ a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with 'sufficient specificity' to constitute an anticipation under the statute." M.P.E.P. §2131.03 further defines 'sufficient specificity' as being fact dependent. For example, if the claims are directed to a narrow range, the reference teaches a broad range,⁵ and there is evidence of unexpected results within the

²M.P.E.P. §2131.

³Applicant asserts that this is the case in the present application: the reference discloses 1.8wt% to 93wt%, and claim 1 requires about 75wt% to about 90wt%. As such, the range requirements overlap.

⁴As noted below, the reference fails to disclose any Examples that show a composition that falls within applicant's claimed range of about 75wt% to about 90wt%.

⁵Applicant further asserts that this is the case here; claim 1 of the present application claims between about 75wt% and about 90wt% and the reference discloses the broad range of 1.8wt% to 93wt%. Whereas applicant only claims a range covering about 20%, the reference discloses, but does not enable, a range covering over 90%, or more than four times that of applicant.

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claimed narrow range⁶ . . . it may be reasonable to conclude that the narrow range is not disclosed with 'sufficient specificity' to constitute an anticipation of the claims. In *Ex parte Thumm* the examiner had rejected as anticipated Thumm's claims including a requirement of 0.25% to 2.5% ethylene diamine on the basis of a prior Cox patent disclosing use of an amine, e.g., ethylene diamine, in molar proportions corresponding to substantially overlapping ranges of "0.86 to 8.6%" and "0.86 to 3.44%" (preferred). 132 USPQ 66, 68 (PTO Bd. of Apps. 1960). In overturning the rejection, the Board of Patent Appeals stated:

It is evident from the first two full paragraphs in column 8 of the [Cox] reference that the amount of amine, based upon the weight of cellulose, covers a rather broad range. The range specified in the appealed claims is much narrower and, although the two ranges overlap to a certain extent, such circumstance does not preclude the grant of a patent when the applicant satisfactorily establishes that he obtains results which are unobvious and unexpected and that his claims do not read upon a particular embodiment of the reference.

Applicant asserts that this instant case is similar to *Ex parte Thumm*. Specifically, Applicant asserts that Mori does not disclose Applicant's subject matter with "sufficient specificity" to anticipate claim 1.

As noted above, Mori discloses a thermoplastic elastomer composition comprising the broad range of 20 to 1,500 parts by weight of a rubber component. When considering the other required components, this is equivalent to a range of from about 1.8% (based on the total weight of the thermoplastic elastomer

⁶Applicant has shown such results in the Examples of the specification as discussed below.

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composition) to about 93% (based on the total weight of the thermoplastic elastomer composition) of the rubber component. This broad range does overlap Applicant's claimed range of 70% to 90% for the rubber component. However, a close review of the working Examples and Table 1 shows that the amount of rubber component actually enabled by the various adhesive compositions disclosed in the cited reference ranged from about 12% (based on the total weight of the thermoplastic elastomer composition) to about 57% (based on the total weight of the thermoplastic elastomer composition). More specifically, when the working examples use styrene/butadiene/styrene block copolymer as the rubber component, as required by Applicant's claim 1, the amount of rubber component utilized in various adhesive compositions evaluated were 12%, 35.7%, and 50%. These values are far below the broadest endpoint range of 93% as set forth in the reference. Furthermore, these values are far below the lower limit of 75% as required in the instant invention.

Claim 1, as discussed above, requires a range of 75% to 90% rubber based adhesive. The principle teaching that one skilled in the art would take away from a thorough reading of Mori is that substantially less than 75% of the rubber component should be utilized in preparing the adhesive composition; Mori actually fails to enable one skilled in the art to anything above about 57%. All of the working examples support an amount substantially less than that of the lower limit of 75% as required in the instant invention. Because Mori does not set forth a sufficient enabling disclosure of the subject matter in instant claim 1, the Office has failed to show that Mori discloses each and every limitation with sufficient specificity to anticipate claim 1. Simply setting forth extremely broad ranges without an enabling

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disclosure does not constitute anticipation. As such, claim 1 is novel and patentable over the reference.

Claims 2-5, 12 and 14 depend from claim 1 and are patentable for the same reasons as claim 1 set forth above, as well as for the additional elements they require.

3. Rejection of Claims 6-10 and 13 Under 35 U.S.C. §103(a)

Reconsideration is requested of the rejection of claims 6-10 and 13 under 35 U.S.C. §103(a) as being unpatentable over Mori (U.S. 6,248,834).

Claim 6 depends from claim 1 and further requires that the crystalline polymer has a number-average molecular weight between about 3,000 and about 200,000. Claim 1 is patentable for the reasons set forth above. Claim 1 has not been rejected under 35 U.S.C. §103(a). Therefore, claim 6, which depends from claim 1, is patentable for the same reasons as claim 1 above.

Specifically, the cited reference fails to provide an enabling disclosure of an adhesive composition comprising between about 75% and about 90% of a rubber based adhesive. Claims 7-10 and 13 also depend directly from claim 1 and are patentable for the same reasons as claim 1, as well as for the additional elements they require.

In view of the above, Applicant respectfully requests favorable reconsideration and allowance of all pending claims. The Commissioner is hereby authorized to charge Deposit Account No. 19-1345 in the amount of \$110.00 (for a one-month extension of time under 37 CFR 1.136(a)). If there are any additional charges in this matter, please charge our Deposit Account No. 19-1345 in the name of Senniger, Powers, Leavitt & Roedel.

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Respectfully Submitted,



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